

REMARKS/ARGUMENTS

Favorable reconsideration of this application in view of the above amendments and in light of the following discussion is respectfully requested.

Claims 1, 2, 4-11, 13 and 15-23 are pending. The present Amendment amends Claims 1, 22 and 23, and cancels Claims 3 and 14 without prejudice or disclaimer. No new matter is introduced.¹

In the outstanding Office Action, Claims 13-22 were rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter; Claims 1, 3-9, 11 and 14-22 were rejected under 35 U.S.C. § 103(a) as unpatentable over Iwata (U.S. Patent No. 6,697,847) in view of Yanagihara (U.S. Patent No. 6,161,102); Claims 2 and 13 were rejected under 35 U.S.C. § 103(a) as unpatentable over Iwata in view of Yanagihara and Washino (U.S. Patent No. 5,537,157); and Claim 10 was rejected under 35 U.S.C. § 103(a) as unpatentable over Iwata in view of Yanagihara and Kimura (U.S. Patent No. 6,226,097).

In rejecting Claims 13-22 as directed to non-statutory subject matter, the Office Action interprets the computer readable medium recited in Claims 13-22 as a signal. This interpretation of Claims 13-22 is without merit because it fails to give weight to the word medium in the phrase “computer readable medium.” A person having ordinary skill in the art at the time of the invention would recognize that a computer readable medium is not a signal. For example, and not to be construed as limiting, a computer readable medium is a computer element such as a hard disk or a nonvolatile recording medium (such as a flash card). In any case, a computer readable medium is a structural entity, not “just [] a form of a signal carrying data to program a processor,” as asserted in the Office Action.

¹ Support for the amended claims can be found at least in Claims 3 and 14 as previously presented.

Claims 13-22 do not merely recite a computer readable medium, but they recite a computer readable medium storing program code for causing an image forming apparatus to launch an application. As stated in M.P.E.P. § 2106.01 (emphasis added):

...a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, **and is thus statutory**. See *Lowry*, 32 F.3d at 1583-84, 32 USPQ2d at 1035.

Likewise, the computer readable medium storing program code recited in Claims 13-22 defines structural and functional interrelationships between the program code and the rest of the computer which permit the program code's functionality to be realized.

Moreover, the Court of Appeals for the Federal Circuit recently held that "the machine-or-transformation test, properly applied, is the governing test for determining patent eligibility of a process under § 101." See *In re Bilski*, 545 F.3d 943, 956 (Fed. Cir. 2008) (en banc). In particular, the *Bilski* court stated "A claimed process is surely patent-eligible under § 101 if: (1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or thing." *Id.* at 954.

Amended Claim 22 recites, in part (emphasis added):

A computer readable medium storing program code for causing an image forming apparatus to launch an application...

...program code means for displaying a setting screen for setting the launch selection information on a display part of the image forming apparatus, and storing information input from the setting screen as the launch selection information...

Accordingly, the computer readable medium recited in amended Claim 22 is tied to a particular machine: the image forming apparatus. Thus, the computer readable medium recited in Claim 22 is believed to be statutory. It is respectfully requested the rejection of Claims 13-22 under 35 U.S.C. § 101 be withdrawn.

It is respectfully requested the rejection of Claims 1, 3-9, 11 and 14-22 under 35 U.S.C. § 103(a) as unpatentable over Iwata in view of Yanagihara be withdrawn.

Claim 1 recites an image forming apparatus that includes service modules for performing system side processes on image formation in which the applications can be added to the image forming apparatus separately from the service modules. Even prior to the present amendment, Claim 1 recited the image forming apparatus includes an application launch part configured to access launch selection information. The launch selection information indicates at least a location of an auxiliary storage device that stores one or more applications. The launch part is also configured to launch the one or more applications from the auxiliary storage device according to the accessed launch selection information.

Amended Claim 1 incorporates the subject matter previously recited in Claim 3.

Thus, amended Claim 1 further recites (emphasis added):

...a part configured to display a setting screen that sets the launch selection information on a display part of the image forming apparatus, and configured to store information input from the setting screen as the launch selection information...

Claim 22 recites similar features and Claim 23 recites at least the above noted features.

Turning to the applied references, the Office Action acknowledges the “Iwata ‘847 does not explicitly disclose accessing launch selection information, and the launch selection information indicating one or more applications.”² Nevertheless, the Office Action applies Iwata in rejecting the subject matter previously recited in Claim 3, stating:

Iwata ‘847 discloses a part for displaying a setting screen for setting the launch selection information on a display part of the image forming apparatus (**e.g. a display data getting device for getting the display data from the storage device, Abstract, col 3, lines 13-15**), and storing information input from the setting screen as the launch selection information (**e.g. a storage device installed in each**

² See the outstanding Office Action at page 5, lines 14-15.

of the information processing modules for storing display data, Abstract, col 2, lines 66-67).³

Thus, the Office Action identifies the display data in Iwata as the claimed launch selection information. However, Claim 1 requires the claimed launch selection information *to indicate at least a location of an auxiliary storage device that stores one or more applications*, and further recites that a launch part is configured to launch the one or more applications from the auxiliary storage device *according to the launch selection information*.

By contrast, as explained at col. 1, lines 9-12 of Iwata, the display data of Iwata is merely setup information required for job execution that is displayed on an operation panel. Iwata neither discloses nor suggests that the setup information (1) indicates at least a location of an auxiliary storage device that stores one or more applications, or (2) is used by a launch part to launch the one or more applications from the auxiliary storage device. Indeed, as noted above, the Office Action acknowledges that Iwata fails to disclose launch selection information indicating one or more applications. Thus, the display data of Iwata is not equivalent to the launch selection information recited in Claim 1.

Yanagihara fails to cure the above noted deficiencies of Iwata with respect to the above noted features. Accordingly, even the combined teachings of Iwata and Yanagihara fail to disclose or suggest all of the features of amended Claim 1. Applicants respectfully submit that Claim 1, and similarly Claims 22 and 23, patentably distinguish over the combined teachings of Iwata and Yanagihara.

In addition, the further cited Washino and Kimura references do not cure the above noted deficiencies of Iwata and Yanagihara with respect to the above noted features. Accordingly, Applicants respectfully submit that Claims 1, 22 and 23, and claims depending therefrom, are in condition for allowance.

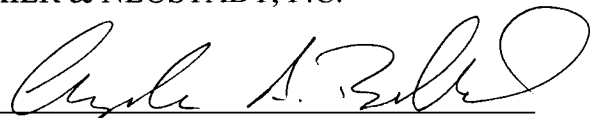
³ See the outstanding Office Action at page 6, lines 10-15.

For the reasons discussed above, no further issues are believed to be outstanding in the present application, and the present application is believed to be in condition for formal allowance. Therefore, a Notice of Allowance for Claims 1, 2, 4-11, 13 and 15-23 is earnestly solicited.

Should the Examiner deem that any further action is necessary to place this application in even better form for allowance, the Examiner is encouraged to contact Applicants' undersigned representative at the below listed telephone number.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



James J. Kulbaski
Attorney of Record
Registration No. 34,648

Customer Number

22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 08/07)

Christopher A. Bullard
Registration No. 57,644